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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/480,472	06/06/95	MCDONOUGH	S 213/066

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EXAMINER
MARSCHEL, A

ART UNIT	PAPER NUMBER
1634	<i>23</i>

DATE MAILED: 01/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/480,472

Applicant(s)

McDonough et al.

Examiner

Ardin Marschel

Group Art Unit

1634



☒ Responsive to communication(s) filed on Oct 2, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 39-42, 48-51, 54-80, and 82-142 is/are pending in the application.

~~Of the above, claim(s) 1-38, 43-47, 52, 53, and 81 have been canceled. is/are withdrawn from consideration.~~

☒ Claim(s) 39-42, 48-51, 54-66, 96-100, and 102-142 is/are allowed.

☒ Claim(s) 67, 68, 74, 75, 84, 85, 92, 94, 95, and 101 is/are rejected.

☒ Claim(s) 69-73, 76-80, 82, 83, 86-91, and 93 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicants' arguments, filed 10/2/98, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 67, 68, 74, 75, 84, 85, 92, 94, 95, and 101 are rejected under 35 U.S.C. § 103(a) as being unpatentable over New England Biolabs Products 1101-1108, taken in view of Somner et al.

New England Biolabs Catalog Product # 1106 is capable of binding to instant SEQ ID NO: 23 as follows:

SEQ ID NO: 23	5'-CCAGGCCACTTCCGCTAACC-3'
Product # 1106	3'-GCTTGGGGAAGCCTAG-5'

The above binding results in said Product suggesting the instant claims 67, 68, 74, 75, and 101. The adaptors of the New England Biolabs Catalog suggest instant claims 84, 85, 92, and 101 as follows:

SEQ ID NO: 22	5'-GCCGTCACCCCACCAACAAGCT-3'
Product # 1101:	3'-GGGCCCCTAG-5'

This binding under amplification conditions is further suggested by Somner et al. in that Somner et al. describes primer amplification wherein the homology is minimal and generally is functional when at least 3 hybridized base pairs exist between the primer.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice the instant invention because Somner et al. suggests that the nucleic acids of New England Biolabs will bind and serve as a primer for amplification reactions. It is noted that the

detectable label of instant claim 92 is present in the Products in that the nucleobases are detectable by UV absorbance. The helper probes of instant claims 94 and 95 are suggested due to sequence similarity which is not limited regarding what is meant by "consisting essentially of" as given in these claims.

Claims 69-73, 76-80, 82, 83, 86-91, and 93 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 39-42, 48-51, 54-66, 96-100, and 102-142 are allowed.

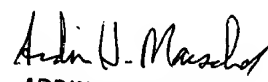
Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

January 4, 1999


ARDIN H. MARSCHEL
PRIMARY EXAMINER